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PTO/SB/21 (09-06)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

15

Application Number

09/997,034

Filing Date

11/28/2001

First Named Inventor

JENS GRIESWALD

Art Unit

2616

Examiner Name

Shick C. Horn

Attorney Docket Number

7123-US

ENCLOSURES (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/
Incomplete ApplicationReply to Missing Parts
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition



Petition to Convert to a



Provisional Application



Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) _____



Landscape Table on CD



After Allowance Communication to TC

Appeal Communication to Board
of Appeals and InterferencesAppeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify
below):

1. Sent by Express Mail #EV 529652568 US
2. Return Receipt Postcard

Remarks

SENT BY EXPRESS MAIL # EV 529652568 US

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Tektronix, Inc.

Signature

Printed name

Thomas F. Lenihan, Reg. No. 32,152 for Matthew D. Rabdau

Date

OCTOBER 23, 2006

Reg. No.

43,026

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

Marilyn Pashby

Date

October 23, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (12-04v2)

Approved for use through 07/31/2006. OMB 0651-0032

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

Complete if Known

Application Number	09/997,034
Filing Date	November 28, 2001
First Named Inventor	JENS GRIESWALD
Examiner Name	Shick C. Horn
Art Unit	2616
Attorney Docket No.	7123-US

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 20-0352 Deposit Account Name: TEKTRONIX, INC.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Fee (\$)	Small Entity Fee (\$)
50	25
200	100
360	180

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP =	x	=	.00

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	x	=	.00

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): APPEAL BRIEF

Fees Paid (\$)

500.

SUBMITTED BY

Signature	<u>Thomas F. Lenihan</u>	Registration No. (Attorney/Agent) 43,026	Telephone 503-627-5068
Name (Print/Type)	Thomas F. Lenihan, Reg. 32,152 for Matthew D. Rabdau		Date October 23, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **JENS GRIESWALD**

Art Unit: **2616**

Serial No.: **09/997,034**

Examiner: **SHICK C. HOM**

Filed: **November 28, 2001**

For: **CIRCUIT ARRANGEMENT FOR TESTING
A COMMUNICATION SYSTEM**

October 24, 2006

Mail Stop: Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

This is an appeal from the Examiner's decision finally rejecting the claims in the above-identified application over prior art.

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Real Party in Interest

The name of the real party in interest in this appeal is Tektronix, Inc., an Oregon corporation.

Related Appeals and Interferences

There are no prior and pending appeals, interferences or judicial proceedings known to Appellant, Appellant's legal representative or Appellant's assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims

Claims 1-10 currently stand rejected under prior art, and are the claims being appealed.

Status of Amendments

The amendment filed subsequent to the Examiner's final rejection has been entered by the Examiner.

Summary of Claimed Subject Matter

Appellant's invention is a circuit arrangement for testing a communication system where the communication is subdivided into functional layers, such as the OSI (Open Systems Interconnection) communication model. The circuit arrangement **16** has a port **32** that allows a test apparatus **28** to communicate directly with a layer higher than the physical layer without the communication previously having to pass through the first layer **14**. (Fig. 6; Abstract) The circuit arrangement may be in a switch that outputs response data to the test apparatus for analysis. The response data may be monitoring data or may be data generated in response to a stimulus provided by the test apparatus. (Page 8, lines 22-23)

Grounds of Rejection to be Reviewed on Appeal

Whether claims 1 and 6 are anticipated under 35 U.S.C. 102(e) by
McElhaney, Jr. et al ("McElhaney") U.S. Patent No. 6,823,479?

Argument

35 U.S.C. 102(e) provides in pertinent part that “[A] person shall be entitled to a patent unless . . . the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.” “A claim is anticipatory only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987)

The Examiner relies upon McElhaney which teaches a network fault analysis tool that is used to schedule and run proactive tests to identify network problems before subscribers are affected, as well as to provide testing on demand to quickly isolate the root cause of a problem identified by the tool or by network management systems or subscribers. The tool is topology independent, and only sends traffic as directed by a network engineer.

More specifically the McElhaney tool provides active testing capabilities across Open Systems Interconnection (OSI) layers two through seven for both basic connectivity and performance as well as common Internet applications. The tool is a hardware/software system that includes protocols, commands, Internet test function libraries, test applications, user interfaces and an Application Program Interface (API). The tool is connected to the Internet in order to send and receive information from web sites connected to the Internet. In other words the tool sends and receives via the physical layer, i.e., communicates with the device being tested through OSI layer one.

Claims 1 and 6:

The Examiner concludes that, because McElhaney recites that the tool is topology independent for providing active testing across OSI layers two through seven, McElhaney clearly reads directly on Appellant’s claims 1 and 6 which recite that the test apparatus communicates “directly with any layer that is higher than a first layer of the functional layers without the communication previously having to pass through the first layer.” However Fig. 1 clearly shows that the McElhaney tool

connects to the Internet and not to a port that allows communication *directly* with layers two through seven, i.e., McElhaney necessarily has to communicate with the network via the physical or first layer, contrary to the Examiner's conclusion.

The claim language cannot be read in a vacuum to encompass more than is described in the specification. Appellant's Fig. 6 clearly shows that the test apparatus **28** is coupled *directly* via a port **32** to a device being tested **16** at functional layers above the physical or first layer **14**. This clearly supports the claim language of communicating "without the communication previously having to pass through the first layer." The Examiner's interpretation of McElhaney would negate this language in claims 1 and 6. Although McElhaney tests layers two through seven, McElhaney does so by communicating via the physical or first layer as in Appellant's described prior art. Therefore claims 1 and 6 are deemed to be allowable as being neither anticipated nor rendered obvious to one of ordinary skill in the art over McElhaney.


Claim 6:

Claim 6 further specifically recites the testing of a switch, with the switch containing "a circuit arrangement having a port that allows communication by a test apparatus." McElhaney does not disclose a switch having such a specific circuit arrangement that allows communication with a test apparatus "directly with any layer that is higher than a first layer of the functional layers." McElhaney only discloses a tool that is equivalent at best with the test apparatus, and does not teach or suggest that an element of the network, such as a switch, have a special circuit arrangement so that the tool can connect directly to the switch without having to go through the Internet, i.e., without first passing through the first functional layer. Therefore claim 6 is further deemed to be allowable as being neither anticipated nor rendered obvious to one of ordinary skill over McElhaney.

Conclusion:

Thus Appellant submits that claims 1 and 6, together with claims 3-5 and 7-10 dependent therefrom, are allowable, and Appellant urges that the Examiner's rejection of claims 1-10 be reversed and this case be passed to issue.

Respectfully submitted,
JENS GRIESWALD

By 
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Attorney's Docket No. 7123-US

Claims Appendix

Claim 1. A circuit for testing a communication system that is subdivided into functional layers comprises a port that allows communication by a test apparatus directly with any layer that is higher than a first layer of the functional layers without the communication previously having to pass through the first layer.

Claim 2. The circuit arrangement according to claim 1 wherein the functional layers correspond to an OSI reference model.

Claim 3. The circuit arrangement according to claims 1 or 2 wherein the communication comprises data input into and/or data output from the port .

Claim 4. The circuit arrangement according to claim 3 wherein processing of the communication is realized on a single chip, with the port being provided on the chip.

Claim 5. The circuit arrangement according to claim 3 wherein processing of the communication is realized on a first chip and the port is on a second chip, the first and second chips being linked with each other for data transfer.

Claim 6. A method for testing a switch for a telecommunication network that is subdivided into functional layers comprising the steps of:

providing the switch with a circuit arrangement having a port that allows

communication by a test apparatus directly with any layer that is higher than a first layer of the functional layers without the communication previously having to pass through the first layer;

outputting response data from the port to the test apparatus; and

analyzing the response data by the test apparatus.

Claim 7. The method according to claim 6 further comprising the step of inputting test data into the port before the outputting step.

Claim 8. The method according to one of claims 6 or 7 wherein the test data comprise a stimulation signal.

Claim 9. The method according to claim 8 wherein the response data comprise a response to the stimulation signal.

Claim 10. The method according to claim 6 wherein the response data comprise a monitoring signal.

Evidence Appendix

No evidence was submitted in this case under Sections 1.130, 1.131 or 1.132 of 37 C.F.R. or entered by the Examiner upon which Appellant is relying in this appeal.

Related Proceedings Appendix

There are no related proceedings related to or which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.